

C/APJ Stoner

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RICHARD C. KRAMP,
Junior Party,¹

v.

RAYMOND T. BISHOP,
Senior Party.²

MAILED

MAR 19 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 104,067

Before METZ, PATE, and HANLON, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658(a)

This is a final decision under 37 CFR § 1.658(a) in Interference No. 104,067. The parties involved in this interference are Richard C. Kramp (Kramp) and Raymond T. Bishop (Bishop). Bishop is senior party by virtue of the July 20, 1993,

¹Application 08/110,909, filed August 24, 1993. Assigned to Waste Tire Grinder Co., Inc.

²Patent No. 5,390,861, granted February 21, 1995, based on Application 08/094,506, filed July 20, 1993. Assigned to National Rubber Recycling, Inc., San Antonio, Texas.

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filing date of U.S. Patent No. 5,390,861, involved in this interference.

The sole count at issue in this interference relates to reducing rubber tire material having metal stranding to a pulverulent form. The count reads as follows:³

COUNT 1

Claim 1 of U.S. Patent No. 5,390,861 to Bishop

or

claim 5 of U.S. Patent No. 5,390,861 to Bishop

or

claim 25 of Application 08/110,909 to Kramp

or

claim 26 of Application 08/110,909 to Kramp.^{4,5}

³The copy of the count appearing in Appendix I of the junior party's brief is incorrect. Namely, the first and third alternatives of the count (claim 1 of U.S. Patent No. 5,390,861 to Bishop and claim 25 of Application 08/110,909 to Kramp) are missing and certain language appearing in the second and fourth alternatives of the count (claim 5 of U.S. Patent No. 5,390,861 to Bishop and claim 26 of Application 08/110,909 to Kramp) is also missing. A correct copy of the count is reproduced in this decision.

⁴Claim 1 of U.S. Patent No. 5,390,861 to Bishop and claim 25 of Application 08/110,909 to Kramp read as follows:

A method of reducing rubber tire material having a metal constituent to a pulverulent form having a predetermined range of particulate dimension, comprising:

(continued...)

⁴(...continued)

(a) providing a pair of generally cylindrical relatively movable surfaces disposed in radially spaced converging relation and defining at least one rubber tire processing chamber therebetween having an inlet opening into which rubber tire material is fed and a discharge opening from which pulverulent rubber tire material is discharged therebetween for movement of rubber tire material therethrough, said rubber tire processing chamber having a plurality of circumferentially spaced inclined wedge surfaces each defining gradually reducing clearance between said relatively movable surfaces in the direction of rubber tire material movement within said rubber tire processing chamber;

(b) imparting relative movement to said relatively movable surfaces causing movement of said rubber tire material within said processing chamber;

(c) forcing said rubber tire material to move through said processing chamber and through into said gradually reducing clearance defined by said plurality of circumferentially spaced inclined wedge surfaces, during said relative movement of said surfaces during said relative movement, said inclined wedge surfaces applying mechanical compression to said rubber tire material by wedging activity causing said rubber tire material to be worked against said metal constituent thereof and mechanically broken down to a pulverulent form; and

(d) discharging pulverulent rubber tire material from said outlet following pulverization of said rubber tire material.

⁵Claim 5 of U.S. Patent No. 5,390,861 to Bishop and claim 26 of Application 08/110,909 to Kramp read as follows:

Apparatus for reducing rubber tire material having metal stranding to a pulverulent form, comprising:

(a) a generally cylindrical housing;

(b) a generally cylindrical member being located within said generally cylindrical housing and being disposed in radially spaced relation therewith;

(c) said generally cylindrical housing and generally cylindrical member defining a pair of relatively longitudinally movable surfaces being disposed in diverging relation and cooperatively defining at least one elongate rubber tire material processing chamber having first and second ends, said first end

(continued...)

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The claims of the parties designated as corresponding to Count 1 are:

Kramp: Claims 1-26

Bishop: Claims 1-15

Background

Junior party Kramp filed a preliminary statement but did not file any preliminary motions. Times were set for the junior party to take testimony and file a record and a brief at final

⁵(...continued)

defining an inlet opening and said second end defining discharge opening;

(d) at least one wedge plate being located within said generally cylindrical housing and cooperating with said generally cylindrical member to define a processing chamber therebetween said wedge plates cooperatively defining said inlet opening and said discharge opening;

(e) a wedging surface being defined by at least one of said relatively longitudinally movable surfaces and being oriented in inclined relation with the opposite one of said relatively longitudinally movable surfaces, upon relative movement of said wedging surface and said other relatively movable surface rubber tire material present between said wedging surface and said other relatively longitudinally movable surface being subjected to mechanical compression and internal shear forces anti being worked against said metal stranding to break down said rubber tire material to a pulverulent form for discharge from said material processing chamber through said discharge opening;

(f) means for feeding rubber tire material into said processing chamber; and

(g) means for receiving pulverulent rubber tire material from said discharge opening.

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hearing.⁶ Junior party Kramp took testimony and filed a record and a brief, but waived its opportunity to appear, through counsel, at final hearing for oral argument. See Paper No. 30.

Issues

Kramp raises the issues of priority of invention and derivation in his brief at final hearing. See Brief, page 5.

Junior party Kramp's case for priority

I.

As the junior party in an interference between co-pending applications, junior party Kramp bears the burden of proving priority by a preponderance of the evidence. Cooper v. Goldfarb, 154 F.3d 1321, 1326, 47 USPQ2d 1896, 1900 (Fed. Cir. 1998); see also Bosies v. Benedict, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994).

In his brief, Kramp points out that his evidence of prior invention is "incontroverted." See Brief, page 8; see also Trzyna affidavit dated January 28, 2000, paragraph 18 ("This Interference is uncontested."). However, the senior party's failure to file a brief at final hearing does not relieve the

⁶A time was also set for senior party Bishop to file a brief at final hearing. See Paper No. 15. However, the senior party did not file a brief. See Paper Nos. 18 and 19; Service by Publication under 37 CFR § 1.646, 1217 Off. Gaz. Pat. & Trademark Office 154 (Dec. 29, 1998).

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junior party of its initial burden of establishing priority by a preponderance of the evidence. See Fitch v. Cooper, 139 USPQ 382, 382 (Bd. Pat. Int. 1962) (notwithstanding uncontested nature of the case, the senior party is still presumed to be the first inventor, and the burden of proof rests upon the junior party to overcome this presumption). Rather, Bishop is restricted to the July 20, 1993, filing date of U.S. Patent No. 5,390,861, involved in this interference.

II.

Kramp alleges a date of conception and an actual reduction to practice as early as December 23, 1992. Since the alleged actual reduction to practice occurred prior to Bishop's effective filing date, Kramp only needs to establish an actual reduction to practice of the subject matter of the count prior to July 20, 1993, Bishop's effective filing date, to prevail in this interference. See Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993) ("Priority goes to the first party to reduce an invention to practice unless the other party can show that it was the first to conceive the invention

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and that it exercised reasonable diligence in later reducing that invention to practice."').⁷

In his brief at final hearing, Kramp relies on a disclosure document dated December 23, 1992, to establish an actual reduction to practice on even date. See Kramp Exhibit 1. According to Kramp, the disclosure document, particularly copies of photographs attached thereto and a listing of "parts," shows that a machine corresponding to the subject matter of the count was made and operated at least as early as December 23, 1992. See Brief, pages 7-8.

Kramp further argues that the alleged actual reduction to practice is corroborated by Peter K. Trzyna and Leslie F. Chard, III, who were said to have received the disclosure document on or about December 23, 1992. The disclosure document is said to have been acknowledged in a patentability opinion dated February 19, 1993, and signed by Peter K. Trzyna and Leslie F. Chard, III. See Brief, p. 7; Kramp Exhibit 2, p. 1.

⁷Alternatively, a party may establish priority by proving a conception of the subject matter of the count before the senior party's effective filing date, coupled with reasonable diligence prior to that date up to a constructive reduction to practice. Wilson v. Sherts, 81 F.2d 755, 759, 28 USPQ 379, 383 (CCPA 1936). However, Kramp cannot establish priority in this manner because Kramp has made no assertion or showing of diligence. Paine v. Inoue, 195 USPQ 598, 603 (Bd. Pat. Int. 1976).

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According to Mr. Trzyna (Trzyna affidavit dated January 28, 2000, paragraphs 8 and 9):

8. On or about December 23, 1992, Leslie F. Chard, III and I were provided a memorandum entitled "Tire Grinder" and dated December 23, 1992, together with a series of accompanying photographs and listing of part numbers identified in the drawings for the purposes of conducting a patentability search.

9. The disclosure documents comprising the memorandum and a series of photographs and number code listing of items numbered on photographs is attached to the Affidavit of Leslie F. Chard, III, as Exhibit 1.

Leslie F. Chard, III adds (Chard affidavit dated January 28, 2000, paragraphs 5 and 6):

5. I remember seeing a disclosure memorandum including a number code description list relating to photographs forming part of the memorandum for the invention entitled "Tire Grinder", a copy of the disclosure memorandum and attachments is attached hereto and labeled as Exhibit 1.

6. The photographs disclosed a functional, constructed embodiment of the "Tire Grinder" as described in Jr. Party Kramp's application now involved in this interference.

III.

In order to establish an actual reduction to practice of the subject matter of a count, an inventor must prove that: (1) he constructed an embodiment or performed a process that met all the limitations of the interference count, and (2) he determined that the invention would work for its intended purpose. Cooper,

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154 F.3d at 1327, 47 USPQ2d at 1901; Newkirk v. Lulejian, 825 F.2d 1581, 1582, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987).

Depending on the complexity of the invention, testing may or may not be necessary to establish that a particular invention works for its intended purpose. The court has held that "[t]here are some devices so simple that a mere construction of them is all that is necessary to constitute a reduction to practice." Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 254 (CCPA 1931). However, "reduction to practice of a complex mechanical device . . . [requires] that the device was subjected to a test under actual working conditions which demonstrated not that the device might work, but that it actually did work." Chandler v. Mock, 150 F.2d 563, 565, 66 USPQ 209, 211 (CCPA 1945).

Similarly, the Court in Field v. Knowles, 183 F.2d 593, 601, 86 USPQ 373, 379 (CCPA 1950) explained:

To constitute an actual reduction to practice of a machine, the device must be completed in an operative form capable of successfully demonstrating its practical utility in its intended field of use. . . . Unless the device is of such a nature that by its very simplicity its practical operativeness is manifest, . . . the machine must be tested under actual working conditions, . . . in such a way as to demonstrate its practical utility for its intended purpose, . . . beyond probability of failure Actual performance is required of the function for which the machine is intended with a quality, extent, and character of operation sufficient to indicate its

utility in the environment in which it is contemplated to be useful. [Citations omitted.]

Based on the complexity of the tire grinding apparatus at issue, which is intended to reduce rubber tire material having metal stranding to a pulverulent form, we find that the apparatus is not so simple that its mere construction demonstrates its workability. Therefore, junior party Kramp must show that the embodiment relied upon as evidence of an actual reduction to practice was tested and that it worked for its intended purpose, i.e., reducing rubber tire material having metal stranding to a pulverulent form. Compare Campbell v. Wettstein, 476 F.2d 642, 646-47, 177 USPQ 376, 379 (CCPA 1973) (where the interference counts contain no limitation relating to intended use, evidence establishing substantial utility for any purpose is sufficient to show reduction to practice).

Junior party Kramp does not appear to dispute that testing is necessary in this case. Rather, Kramp argues that photographs attached to the disclosure document show that a machine corresponding to the subject matter of the count was tested and that it worked for its intended purpose. See Brief, page 8.

The photographs appear to show various views of a machine by itself or in combination with a quantity of material. It is impossible to tell from the photographs alone (1) whether the

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material was modified, e.g., pulverized, during the machine's operation and (2) whether the material is pulverized rubber and metal stranding.

Kramp argues that the photographs show "pulverized rubber material" which has been discharged from the machine pictured therein. Brief, page 8. However, without the support of evidence in the record, Kramp's arguments are insufficient to establish that the machine worked for its intended purpose. See In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (arguments in the brief do not take the place of evidence in the record); Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854 (1977) (arguments of counsel cannot take the place of evidence lacking in the record).

We note that in an affidavit Mr. Chard states that the photographs disclose "a functional, constructed embodiment of the 'Tire Grinder' as described in Jr. Party Kramp's application now involved in this interference." Chard affidavit dated January 28, 2000, paragraph 6. However, Mr. Chard fails to identify the function being performed in the photographs by the machine pictured.

Finally, even if we accept Kramp's argument that "pulverized rubber material" was discharged from the machine pictured in the

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photographs, Kramp has nonetheless failed to establish that the machine worked for its intended purpose. As discussed above, Kramp must show that the machine successfully reduced rubber tire material having metal stranding to a pulverulent form.

Based on the record before us, Kramp has failed to demonstrate that the embodiment relied on to establish an actual reduction to practice of the subject matter of the count worked for its intended purpose. For this reason, Kramp has failed to establish an actual reduction to practice of the subject matter of the count.⁸

IV.

As discussed above, in order to establish an actual reduction to practice of the subject matter of a count, an

⁸A reduction to practice must also be independently corroborated. Mikus v. Wachtel, 542 F.2d 1157, 1159, 191 USPQ 571, 573 (CCPA 1976); see also Reese v. Hurst, 661 F.2d 1222, 1228, 211 USPQ 936, 940 (CCPA 1981) ("adoption of the 'rule of reason' has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself"). Kramp relies on the testimony of Peter K. Trzyna and Leslie F. Chard, III to corroborate the alleged actual reduction to practice. See Trzyna affidavit dated January 28, 2000, paragraphs 8 and 9; Chard affidavit dated January 28, 2000, paragraphs 5 and 6. However, the evidence of record fails to establish that either Mr. Trzyna or Mr. Chard saw the embodiment at issue in operation. Therefore, Mr. Trzyna and/or Mr. Chard cannot corroborate Kramp's alleged actual reduction to practice. For this additional reason, Kramp has failed to establish an actual reduction to practice of the subject matter of the count.

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inventor must also prove that he constructed an embodiment or performed a process that met all the limitations of the count. Cooper, 154 F.3d at 1327, 47 USPQ2d at 1901; Newkirk, 825 F.2d at 1582, 3 USPQ2d at 1794. For completeness, we will examine whether Kramp has shown that the embodiment relied on to establish an actual reduction to practice met all the limitations of the count.

Kramp argues that the disclosure document, including copies of photographs attached thereto and a listing of "parts," establishes that a machine corresponding to the subject matter of the count was made as early as December 23, 1992. See Brief, pages 7-8.

Significantly, Kramp fails to show a correspondence between the "parts" of the machine described in the disclosure document and the limitations of the count. See Cooper, 154 F.3d at 1328, 47 USPQ2d at 1902 ("the physical embodiment relied upon as an actual reduction to practice must include every limitation of the count. . . . What this means is that, in order to rely on Dr. Sharp's successful experiment as a reduction to practice, Cooper was required to establish that Dr. Sharp's graft had fibril lengths within the parameters of the count."). Furthermore, a review by this panel appears to reveal that the machine does not

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meet all the limitations of the count. For example, the disclosure document, including the parts list, fails to establish that the machine pictured comprises a "generally cylindrical housing and generally cylindrical member defining a pair of relatively longitudinally movable surfaces being disposed in diverging relation" (emphasis added) as required by the count.

Without more, Kramp has failed to show that he constructed an embodiment that met all the limitations of the count. See Cooper, 154 F.3d at 1326, 47 USPQ2d at 1900 (junior party bears the burden of proving priority by a preponderance of the evidence). Therefore, for this additional reason, junior party Kramp has failed to establish an actual reduction to practice of the subject matter of the count.

V.

Finally, Kramp argues that senior party Bishop derived his invention from junior party Kramp. Specifically, Kramp argues that the minutes of a shareholders' meeting of Waste Tire Grinder Company, Inc. dated April 23, 1993 (Kramp Exhibit H-1), and a conflicts check report dated December 22, 1992 (Kramp Exhibit T-1) establish that senior party Bishop had knowledge of junior party Kramp's invention as early as December 22, 1992. See Brief, page 8.

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Roger Hardee is said to "confirm" Bishop's knowledge of Kramp's invention in an affidavit wherein Mr. Hardee states (Hardee affidavit dated January 28, 2000, paragraph 5):

5. Proof of Mr. Bishop's knowledge of the invention of Mr. Kramp will be confirmed by the Minutes of Stockholders' Meeting dated April 23, 1993, attached hereto and labeled as Exhibit H-1, showing him to be a shareholder in the Assignee at a point prior to his filing date as Sr. Party in this interference.

VI.

To prove derivation, a party must show (1) prior conception of the subject matter of the count and (2) communication of the conception to the opponent. Price, 988 F.2d at 1190, 26 USPQ2d at 1033; Hedgewick v. Akers, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974). The subject matter communicated must have been sufficient to enable one of ordinary skill in the art to construct and successfully operate the invention. Mead v. McKirnan, 585 F.2d 504, 507, 199 USPQ 513, 515 (CCPA 1978).

The record is simply devoid of any evidence which establishes that a conception of the subject matter of the count was communicated to Bishop. See Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985) (to establish conception a party must show every feature recited in the count). The shareholder minutes merely mention a "tire grinding machine," and the conflicts check report does not even refer to a "tire

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grinding machine." See Kramp Exhibit H-1, pp. 3 and 4; Kramp Exhibit T-1. Without more, Kramp's case for derivation must fail.⁹

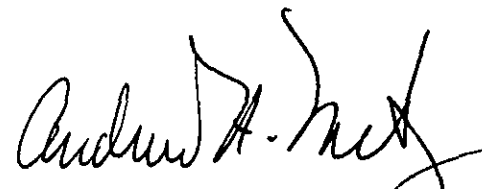
Judgment

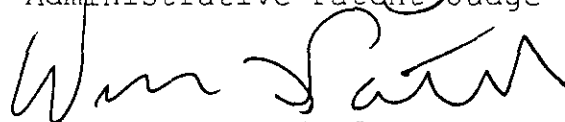
Judgment as to Count 1, the sole count in issue, is entered against the junior party, Richard C. Kramp. Richard C. Kramp is not entitled to a patent containing claims 1-26 which correspond to Count 1.

⁹Inurement, on the other hand, involves a claim by an inventor that, as a matter of law, the acts of another person should accrue to the benefit of the inventor. Cooper, 154 F.2d at 1331, 47 USPQ2d at 1904. Junior party Kramp has provided no evidence that work performed by senior party Bishop should accrue to the benefit of Kramp. Therefore, Kramp cannot rely on any activities by Bishop to establish an actual reduction to practice prior to July 20, 1993.

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Judgment as to Count 1 is awarded in favor of the senior party, Raymond T. Bishop. On the record before the U.S. Patent and Trademark Office in this interference, Raymond T. Bishop is entitled to his patent containing claims 1-15 which correspond to Count 1.


ANDREW H. METZ)
Administrative Patent Judge)


WILLIAM F. PATE, III)
Administrative Patent Judge)


ADRIENE LEPIANE HANLON)
Administrative Patent Judge)

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